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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/759,650 | 01/16/2004 | James E. Manuel | 016295.1559 (DC-05989) | 8070 |
| 23640 | 7590 | 04/04/2006 | EXAMINER | |
| BAKER BOTTS, LLP 910 LOUISIANA HOUSTON, TX 77002-4995 | | | PICKETT, JOHN G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |
| DATE MAILED: 04/04/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,650

Applicant(s)

MANUEL, JAMES E.

Examiner

Gregory Pickett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 November 2005 has been entered. Claims 1-6, 8-12, and 14 are pending in the application. Claims 7, 13, and 15-20 have been canceled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Applicant's affirmation of the election of Group I in the reply filed on 30 November 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

4. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Keil (US 3,410,474; previously provided).

Claim 1: It is noted that the only structure recited in the claim is for a packing support having a top section and a bottom section with at least three detachable joints; all other limitations are intended use recitations. Accordingly, Keil discloses a packing support (Figure 2) with a top section **2 & 16** and a bottom section **18** with at least three detachable joints **12/14** operably detachable to cause the top section to separate from the bottom section (see Figure 2). Depending upon the unclaimed/undisclosed packing system, the joints of Keil are fully capable of maintaining the support intact while being packed and to allow the top section to be detached from the bottom section as claimed.

Claim 2: the joints of Keil are reusable.

Claim 3: Keil discloses a foam material (Col. 2, lines 34-39).

Claim 6: Keil discloses dovetail joints **12/14**.

5. Claims 4 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Keil.

Claims 4 and 5 are product-by-process claims. Keil, as applied to claim 1 above discloses the claimed structures. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim Rejections - 35 USC § 103

6. Claims 8-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figure 1 of the instant application (hereinafter PA1) in view of Keil.

Claims 8, 10, and 11: PA1 teaches the provision of a computer system **9** within a top-to-bottom support **4 & 6** and shipping container **2**. Applicant has admitted that the provision of a printed circuit board, processor, memory, and chassis within a computer system was common and conventional and that their provision within the computer system **9** of PA1 would have been obvious.

PA1 discloses the claimed invention except that PA1 uses a top-to-bottom support that completely surrounds the computer system instead of a corner-type support system that only receives a portion of the chassis. Keil shows that a corner-type support system that only receives a portion of the retained product was an equivalent structure known in the art. Therefore, because these two supports were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the corner-type supports of Keil for the top-to-bottom supports of PA1.

Keil discloses a detachable container support (Figure 2) designed to receive a fragile item and having a first section **2 & 16**, a second section **18**, and detachable joints **12/14**. Joints **12/14** are dovetail joints and are capable of maintaining their connection while being packed. Further, the support is made of a resiliently deformable foam material (Col. 2, lines 34-39). It is noted that the disclosure of the applicant allows that resilient deformation of the dovetail joint for separation of the top and bottom section is

a suitable arrangement (page 18, lines 21-24 of the instant application). As such, resilient deformation is considered "operably designed". Since the assembly of Keil is made of resiliently deformable foam, the joints **12/14** will deform and release their connection. As such, the system of Keil is considered "operably designed" to be detached from the bottom section while the product and bottom sections are still retained in the outer shipping container.

Claim 9: the joint of Keil is reusable.

Claims 12 and 14 are product-by-process claims. PA1-Keil, as applied to claim 8 above, discloses the claimed product. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

7. Applicant's arguments with respect to claims 1-6, 8-12, and 14 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
24 March 2006



Mickey Yu
Supervisory Patent Examiner
Group 3700